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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,867	11/29/2001	Ying Wen Hsu	263/288	7758
34313	7590	01/22/2004		
ORRICK, HERRINGTON & SUTCLIFFE, LLP 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558			EXAMINER HEALY, BRIAN	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/998,867	Applicant(s) HSU, YING WEN	
	Examiner Brian M. Healy	Art Unit 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-51 and 64-73 is/are rejected.
- 7) ☒ Claim(s) 52-63 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>same</u> . | 6) <input type="checkbox"/> Other: |

Art Unit: 2874

ALLOWABLE SUBJECT MATTER

Claims 52- 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the references of record with the method and apparatus of attenuating an optical signal which further a prism coupler coupled between the first and third waveguides with the prism coupler propagating the optical signal between the first and the third waveguide and the use of springs attached to the substrate to enable the movement of the movable light transmissive structure, the recited electrode structures and oxide and buffer layers recited in the aforementioned claims.

102 REJECTIONS

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6,8,9,10,12,14,15,16-25,28,29,31-34,41-43,45, 46,66-69,71 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Harman, U.S.P. No.5,727,099.

Harman 099' teaches (Figs.1-9) a method and apparatus of attenuating an optical signal comprising: a second light transmission structure or optical fiber 28 on a movable (or pivotable/rotatable) platform 26 that moves the second light transmission structure or optical fiber 28 to a first unattenuated position to a second position that attenuates (Note that the amount of attenuation can be total or zero) a light signal propagating in the first light transmission structure to a first light transmission structure 32 or optical fiber via a variable free spaced air gap 30 which clearly, fully meets Applicant's claimed limitations.

Claims 1-51, and 64-73 are rejected under 35 U.S.C. 102(e) as being anticipated by Espindola et. al., U.S.P. No.6,102,582.

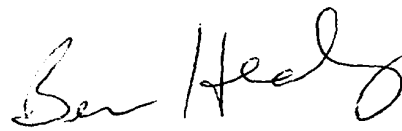
Espindola et. al. '582 teaches (Figs.1-9) a method and apparatus for switching and /or attenuating comprising a movable platform 72 upon which is placed a second light transmissive structure or optical fiber waveguide 71 that moves and/or rotates between first optical fiber transmissive structures 80A,B and a third optical fiber transmissive structure 75A,B wherein there are variable free space air gaps between the first, second and third optical fiber transmissive structures so that light signals are either unattenuated, fully or partially attenuated between the first, second and third optical fiber waveguides, which clearly, fully meets Applicant's claimed limitations.

Any inquiry concerning the merits of this communication should be directed to Examiner BRIAN M. HEALY at telephone number (571) 272-2347. Any inquiry of a general or clerical nature (i.e. a request for a missing form or paper, etc.) should be directed to the Technology Center 2800 receptionist at telephone number (703) 308-0956, to the technical support staff supervisor (Team 2) at telephone number (703) 308-3072, or to the Technology Center 2800 Customer Service Office at telephone number (703) 306-3329.

BRIAN M. HEALY
Primary Patent Examiner
Group Art Unit 2874

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hsu, U.S. Patent Application Publication No. U.S. 2002/0054748A1 (Note entire reference.), Dorsey, U.S.P. No.5,095,519 (Figs.1-11), Robinson, U.S.P. No.6,137,941 (Figs.1-4) and Pan, U.S.P. No.5,864,643 (Figs.1-7C).

All of the prior art documents submitted by applicant in the Information Disclosure Statement filed on March 04, 2002, have been considered and made of record. Note the attached initialed copy of form PTO-1449.


Brian M. Healy
Primary Examiner